

## **REMARKS/ARGUMENTS**

Applicants have received and carefully reviewed the Final Office Action of July 20, 2009 and the Advisory Action of October 26, 2009. This amendment is filed along with a Request for Continued Examination. Claims 9, 12, 16, 17, and 19-23 are pending and have been rejected. With this amendment, claims 9, 21, and 23 have been amended, claim 20 has been canceled, and new claims 38-42 are presented. Favorable consideration of the above amendments and the following remarks is respectfully requested.

### ***Claim Amendments***

Claim 9 has been amended to clarify the relationships among certain claim elements.

Claim 20 has been canceled without prejudice.

Claim 21 has been amended to correct dependency following the cancellation of claim 20.

Claims 21 and 23 have been amended to clarify certain terminology to better align the claims with previous amendments.

New claims 38-42 are presented herein. Dependent claims 38-39 add additional elements to independent claim 9, which is believed to be patentable for at least the reasons discussed below. New independent claim 40, and dependent claims 41-42 which add additional elements thereto, contains similar and additional claim elements to claim 9. The cited references, alone or in combination, do not appear to disclose or suggest each and every element of claim 40 as claimed.

No new matter has been added. The amendments and new claims find support in the elected Figures as well as the specification, for example, from page 5, line 8 to page 6, line 4, and at page 8, lines 4-11. Favorable consideration of the above amendments is respectfully requested.

### ***Claim Rejections – 35 USC § 103***

Claims 9, 12, 16, 17, and 19-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin et al. (U.S. Publication No. 2003/0125751) in view of Muni et

al. (U.S. Patent No. 5,316,706). With this amendment, claim 20 has been canceled, rendering its rejection moot. After careful review, Applicants must respectfully traverse this rejection of claims 9, 12, 16, 17, 19, and 21-23.

The Final Office Action acknowledges that Griffin et al. do not teach each and every element of independent claim 9, as is required for a *prima facie* rejection. Muni et al. appear to be advanced solely to provide a tip comprising an amorphous polymer and the radially inextensible distal portion comprises a locally crystalline section thereof. However, as will become evident from the discussion that follows, Griffin et al. do not appear to teach each of the elements asserted to be present in the Final Office Action and Advisory Action. Muni et al. also do not appear to provide those missing elements.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

In the Final Office Action, Griffin et al. is stated to disclose “a distal portion of the guidewire lumen having an inner diameter of substantially the same magnitude as the first diameter (portion 13 clearly has a lumen within it that snugly encompasses the diameter of the guidewire); and a tip (the tip beginning at where the portion 13 ends and the tip extends distally until the very distalmost part of 202)”, citing Figures 46, 47, 49, and 50. The Advisory Action states “the distal portion of the guidewire lumen, such as the portion that 202 surrounds, is much smaller in diameter and is approximately the diameter of the guidewire passing through it”. The Advisory Action also states “the distal tip is capable of inverting proximally into the lumen (inverting into area 13 for example)”. Applicants must respectfully disagree.

Applicants note that independent claim 9 recites, in part, a guidewire having a first diameter; an elongate tubular member having a guidewire receiving lumen extending therethrough, a distal portion of the guidewire lumen having an inner diameter of substantially the same magnitude as the first diameter; and a tip having a lumen therethrough, wherein the tip is configured to invert proximally into the lumen. Accordingly, the disclosure of Griffin et al. and the interpretations of the Final Office Action and Advisory Action do not appear to meet all of the requirements of the claim.

Applicants must respectfully disagree with the interpretation applied to Griffin et

al. on at least two points. Initially, Applicants point out the inconsistent manner in which the asserted lumens appear to have been interpreted. Applicants agree that shank 9 of polymeric member 31 appears to have a narrow lumen extending from the proximal end through the center of feature 13 to insert 202. Insert 202 also appears to have a lumen extending therethrough. The narrow lumen through the center of feature 13 appears to be somewhat “snugly encompassing the diameter of the guidewire” as asserted in the Final Office Action, and the narrow lumen of feature 13 and the lumen of insert 202 appear to be similar in size. However, the Final Office Action asserts that the claimed tip begins where feature 13 ends. Thus the portion of the lumen extending past this point, which appears to include the lumen of insert 202, must be considered as the claimed lumen of the tip, and not the claimed guidewire lumen. Since claim 9 requires that the tip is configured to invert proximally into the lumen (of the tip), and not the guidewire lumen, the claimed inversion must take place distal of feature 13 under the interpretation presented in the Final Office Action. Accordingly, the tip cannot invert into area 13, as asserted in the Advisory Action. Furthermore, it does not appear possible for tip portion 31 to invert into the lumen of the tip as asserted, since the lumen within tip 31 appears to be similar in size to the lumen acknowledged to snugly encompass the diameter of the guidewire. There simply appears to be no place for tip 31 to invert to.

Secondly, in Figures 46 and 49, feature 13 appears to be misidentified. In other embodiments of Griffin et al., reference numeral 13 is disclosed as a guidewire lumen. However, the device(s) shown in Figures 46 and 49 appear to show a different feature labeled as reference numeral 13. The guidewire lumen of Griffin et al. does appear to be present, as a lumen within the center of feature 13. However, Applicants respectfully submit that feature 13 does not itself appear to be a lumen. The Figures in question are described in paragraphs [0299-0307]. It is not immediately clear from the description exactly what feature 13 in these Figures is intended to be, but if feature 13 were a lumen, as asserted in the Final Office Action and the Advisory Action, it should be visible in Figures 47 and 50 as hidden lines. However, feature 13 is not shown in these views, which appears to indicate that the feature is instead some solid portion or feature within shank 9. Additionally, the disclosed guidewire lumen does appear to be visible as its own element within feature 13 in Figures 46 and 49.

While Applicants respectfully disagree with the rejection and interpretations presented, minor amendments clarifying the relationship of certain claim elements are presented herein, in the interest of furthering prosecution. Presentation of the amendments is in no way intended to be construed as acceptance of the asserted interpretations, but is made solely to facilitate a better understanding of the claimed invention and the differences between the claimed invention and the cited references. Therefore, in addition to the deficiencies noted in the discussion above, clarifying language and additional limitations have been added to claim 9 with this amendment that provide further differentiation from the cited references. Griffin et al. and Muni et al., alone or in combination, do not appear to disclose or suggest each and every limitation of amended claim 9.

Applicants also specifically traverse the assertion that tip 31 of Griffin et al. is “perfectly capable of inverting proximally into the lumen if enough pressure is applied to the tip when it abuts an object such as the guidewire stop”. Applicants submit that such an interpretation, particularly in view of the discussion above, is inappropriate, and akin to stating that a cinder block can invert into the spaces therein under enough force. Surely such an interpretation can be seen as inappropriate given the intended use, function, and structure of the device.

Griffin et al. appear to teach a tip which compresses if necessary and withdraws within the catheter lumen to allow the lumen to extend beyond the tip to engulf the filter for removal. As noted in the previous response, numerous Figures appear to indicate that the principle of operation of Griffin et al. is to withdraw the tip, with optional radial compression, well within the catheter. At no time does the distal tip of Griffin et al. appear to invert. For at least this reason, Griffin et al. appear to teach a tip which slides proximally within the catheter lumen to expose a portion of the lumen which is capable of receiving the filter in a collapsed state. This action is described in paragraphs [0266] and [0267]. Even in the embodiment of Fig. 45, where the tip appears to collapse, the tip does not appear to invert.

Furthermore, the conditions set forth to accomplish the asserted inversion, namely “a high enough force” to deform the distal tip and cause it to invert would not appear to be encountered during normal usage of the catheter disclosed by Griffin et al. Applicants

also submit that the “high enough force” may be quite detrimental to the patient being treated as such an event occurs, thereby making the proposed force undesirable. Accordingly, the proposed modification or condition needed to effect the asserted capability appears to impermissibly alter the principle of operation of the Griffin et al. catheter, rendering it unsuitable for its intended use. (MPEP 2143.01 V-VI.).

As noted above, the addition of the polymers of Muni et al. does not appear to overcome the identified deficiencies of Griffin et al. Therefore, Griffin et al. in view of Muni et al. do not appear to teach each and every limitation of independent claim 9, as is required to establish a *prima facie* rejection. Accordingly, claim 9 is believed to be patentable over the cited references. Since claims 12, 16, 17, 19, and 21-23 depend from independent claim 9 and add additional elements thereto, Applicants believe that these claims are also patentable over the cited references. Withdrawal of the rejection is respectfully requested.

### ***Conclusion***

In view of the foregoing, all pending claims are believed to be in condition for allowance. Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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